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Application No. 10/671,607
Docket No. 741124-106REMARKS

By the above actions, claims 1, 3, 5, 6, and 8 have been amended, claims 2 and 7 have been cancelled and a new claim 9 added. In view of these actions and the following remarks, reconsideration of this application is now requested.

Claims 1 and 4 have been rejected under 35 USC § 102 as being anticipated by the disclosure of the patent to Schiff and claim 3 has been rejected as being unpatentable over this reference in combination with Official Notice. Inasmuch as claim 1 now incorporates the subject matter of claim 2, which the Examiner acknowledge is not taught by the Schiff patent, these rejections must now be withdrawn.

However, so as not to be viewed as conceding the correctness of the taking of Official Notice, it is pointed out that doing so by the Examiner in this case was entirely inappropriate. As indicated in MPEP § 2144.03:

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

Even if, for the sake of argument, the use of filter windows with light sensors have been used in some unrelated contexts, such does not make their use obvious in the context of the present invention, and most certainly is not a fact that falls within the scope of something "capable of such instant and unquestionable demonstration as to defy dispute."

Applicant has disclosed that filter windows 18, 18' which are matched to the wavelength range of the laser light are employed to reduce the incidence of outside light on the targets 30, 30'. While Schiff the beam 314 from Schiff's laser 312 passes through several windows 32, 38 of several target devices 310, no mention is made of the need to filter out ambient light nor is any provision made to do so. Clearly, the inference is that such is not needed and for the Examiner to contend that using a filter as disclosed by the present applicant is "capable of instant and unquestionable demonstration as being well-known," then surely he can provide evidence of this fact as well as the missing requisite motivation for using with same Schiff's device as is necessary to support an obviousness rejection.

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Therefore, the Examiner should discontinue any reliance upon official notice with respect to this aspect of the claimed invention and claim 3 in particular.

Claims 2 and 5-8 were rejected by the Examiner under 35 USC § 103 as being rendered obvious by the disclosure of the patent to Schiff when viewed in combination with the disclosure of the Hamar et al. patent. To the extent that this rejection relates to the claims as now presented, it should be withdrawn for the following reasons.

Amended claim 1 now recites the fact that the exit/outlet windows "enable light beams to pass in and out of the housing" and the fact that there are "first and second exit/entrance windows, each of which is at a different side of said beam splitter from each other and said light beam transmitter, wherein the first and second exit/entrance windows are located at sides of the housing which are at right angles relative to each other." These characteristics of the present invention, which can clearly be seen in Figs. 1 & 2 are absent from both Schiff's target device and Hamar et al.'s sensor, so that it is impossible for one of ordinary skill in the art to arrive at the presently claimed invention from these two references no matter how they might be combined, one with the other.

Moreover, the devices of these two references are incapable of being used in the manner of the present invention due to the structural differences recited in claim 1. In this regard, independent claims 5 and 8 go beyond claim 1 in defining a system having three transmitter/receivers that operable for transmitting a light beam to at least one other of the transmitter/receivers and for receiving a light beam from at least one other of the transmitter/receivers for performing alignment measurements of said machine tools based on the positional relationship of the impact points of the light beams in each transmitter/receiver, e.g., in arrangements as shown in Figs. 1 and 2. Again, such a system is neither disclosed nor suggested by these references either singly or in combination nor are they capable of performing the method of claim 8 by which the offset of spindles of three machine tools relative to each other can be determined.

Therefore, the § 103 rejection based on the combination of the Schiff and the Hamar et al. patents should be withdrawn and such action is hereby requested. Furthermore, in the absence of new and more pertinent prior art being discovered, allowance of the claims of this application is also requested. In this regard, the references that have been cited but not applied by the Examiner have been taken into consideration. However, since these references were not

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found to be relevant enough by the Examiner to apply against the original claims, no detailed comments thereon are believed to be warranted at this time.

While this application should now be in condition for allowance, in the event that any issues should remain after consideration of this response which could be addressed through discussions with the undersigned, then the Examiner is requested to contact the undersigned by telephone for that purpose.

Lastly, accompanying this response is a request for extension of time petition and authorization to charge same to the deposit account of the undersigned's firm. However, should this extension of time petition become separated from this Amendment, then it is requested that this Amendment be construed as containing such a petition and the fee therefore should be charged to Deposit Account No. 50-2478(741124-106)

Respectfully submitted,

By: 

David S. Safran
Registration No. 27,997

Customer No. 25570

Roberts Mlotkowski & Hobbes P.C.
P.O. Box 10064
McLean, VA 22102

Direct Telephone: (703) 584-3273

DSS:kmm